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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/526,106 03/15/00 BALINT

R PARE.002.01U

EXAMINER

HM12/0703

BERTRAM I ROWLAND
RAE-VENTER LAW GROUP PC
P O BOX 60039
PALO ALTO CA 94306-0039

WESSENDORF.T

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

07/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/526,106

Applicant(s)

Balint et al

Examiner

T. Wessendorf

Art Unit

1627



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-62 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

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DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, drawn to a method of identifying a functional fragment pair in a protein, classified in class 435, subclass 7.1.
- II. Claims 22-24, drawn to a fragment complementation system, classified in class 530, subclass 350+.
- III. Claims 25-41, drawn to a fragment complementation system using a linker, classified in class 530, subclass 399+ .
- IV. Claims 42-50, drawn to expression cassette and host cells, classified in class 435, subclass 252.3+.
- V. Claim 51, drawn to a method of identifying epitopes that bind to Ig, classified in class 435, subclass 399+.
- VI. Claim 52-54, drawn to a method of identifying interactions between an extracellular domain of a transmembrane protein and a polypeptide, classified in class 435, subclass 7.1.

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VII. Claims 55-57, drawn to a method of monitoring occurrence of protein-protein interactions, classified in class 435, subclass 7.1.

VIII. Claims 58-60, drawn to a method of high-throughput identification of compounds, classified in class 435, subclass 4+.

IX. Claim 61, drawn to an enzyme complementation system, classified in class 530, subclass 300+.

X. Claim 62, drawn to a method of activating Beta lactam of an anti-tumor compound in a host, classified in class 514, subclass 2+.

Inventions I, V, VI, VII, VIII, X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are independent methods having different modes of operation and practicing the method yield different products.

Inventions II, III, IV, IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP

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§ 806.04, MPEP § 808.01). In the instant case the different inventions are different compounds that have different structures and/or functions and capable of different manufacture.

Inventions I, V, VI, VII, VIII, X and II, III, IV, IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions of I, V, VI, VII, VIII, X are method claims which are different from the compound claims of Groups II, III, IV, IX.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CAR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must

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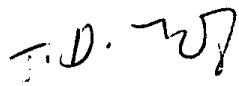
be accompanied by a petition under 37 CAR 1.48(b) and by the fee required under 37 CAR 1.17(I).

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. We encourage your participation in this Pilot program. Please limit the use of this dedicated Fax number to responses to Written Restrictions

Certain papers related to this application may be submitted to Art Unit 1627 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 O.G. 61 (November 16, 1993) and 1157 O.G. 94 (December 28, 1993) (see 37 C.F.R. 1.6(d)). The official fax telephone numbers of the Group are (703)308-7924. NOTE: If applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Wessendorf whose telephone number is (703) 308-3967. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

tdw
7/2/01


T.D. WESSENDORF
PRIMARY EXAMINER